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10/720,814	11/24/2003	Paul W. Gromer	ELO-001.01 (19044-101)	5362
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FOLEY HOAG, LLP			BLACKWELL, JAMES H	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/720,814	GROMER, PAUL W.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James H. Blackwell	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 24 November 2003.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4)  Claim(s) 1-48 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-48 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 24 November 2003 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 03/29/2005.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

1. This Office Action is in response to an original application files 11/24/2003.
2. The priority date is 11/22/2002.
3. Claims 1-48 are pending.
4. Claims 1, 23, 26, 39, and 46 are independent Claims.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 7, 13, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosewarne et al. (hereinafter Rosewarne, U.S. Patent No. 5,729,674 filed 04/07/1995, issued 03/17/1998).

**In regard to independent Claim 1, Rosewarne discloses:**

- A *method for customizing a book* (Abstract; → a method and apparatus for capturing, editing, storing, and reproducing multiple graphic image components for the production of personalized printing materials), *the method comprising:*
  - *receiving a request to customize a book including illustrations and associated words describing the illustrations, at least one of the illustrations including at least one drawing of at least one character* (Pg. 2, Paragraph [0018]; Fig. 1; a customer accesses a Web page provided by a

service provider informing a customer of the various services provided.

Wishing to order a customized book, the customer selects the appropriate icon for a book. The book presented on the Web is actually a template for a book, with the customized information completing the template such that it forms the customized book).

- *based on the request, performing at least one of:*
  - *providing a character appearance feature, the appearance feature:*
    - *related to the appearance of one or more of the at least one character, and*
    - *(ii) associated with selectable appearance options, (Col. 3, line 51 through Col. 4, line 10; Figs. 2, 17-18;→ the ability to illustrate the customer (a character) in personalized, printed material with a focus on children's picture books based on a collection of several data items entered into the computer from the customer. The data items cause a number of discrete drawing components to be assembled into a complete illustration. Illustrations (i.e., characters) can illustrate a full range of human characteristics such as the customer's sex (gender feature, options), ethnic features (appearance feature, option), indications of body size, hairstyle and length, glasses, freckles, and skin coloring (gender and/or appearance options). Different personalized*

materials can be created depending upon the story line or content of the book. The customers' image can be illustrated in a variety of styles ranging from simple line drawings to complex renderings employing fine line quality, shading, and dimension. The customer can be illustrated in a variety of poses, views, postures and expressions through manipulation of the graphic components in the graphic database. A range of color variation in hair from pale blond to black as well as using the complementary skin tones by use of various "overlay screens" printed over the pre-printed color background can be employed).

- *providing a character name feature, the character name feature:*
  - *(i) related to the name of one or more of the at least one character, and*
  - *(ii) associated with selectable name options (Col. 4, lines 33-35; Figs. 2, 17-18; → each finished book will appear as a custom, professionally printed, high quality publication as all personalized material will be fully integrated into the pre-printed material. The text of the book or story is personalized to include names and phrases corresponding to the personalized data from the data/order entry subsystem.).*
- *providing a character gender feature, the character gender feature:*

- *(i) related to the gender of one or more of the at least one character, and*
- *(ii) associated with selectable gender options* (Col. 3, line 59-64; Figs. 2, 17-18;→ Illustrations (*i.e., characters*) can illustrate a full range of human characteristics such as the customer's sex (*gender feature, options*), ethnic features (*appearance feature, option*), indications of body size, hairstyle and length, glasses, freckles, and skin coloring (*gender and/or appearance options*).
- *customizing the book based on associating one or more of the at least one drawing with at least one of:*
  - *a selected appearance option* (Col. 4, lines 22-26;→ that illustrations of faces, hair, and all exposed skin can now have appropriate shading, line details and coloration to achieve a more natural appearance).
  - *at least one word including one of:*
    - *a provided name and a selected name option* (Col. 4, lines 30-51;→ that the text of the book or story is personalized to include names and phrases corresponding to the personalized data from the data/order entry subsystem).

**In regard to dependent Claim 2, Rosewarne discloses:**

- *the appearance options are based on the appearance of humans* (Col. 3, line 51 through Col. 4, line 10; Figs. 2, 17-18;→ the ability to illustrate the customer (typically a human) in personalized, printed material with a focus on children's picture books based on a collection of several data items entered into the computer from the customer).

**In regard to dependent Claim 3, Rosewarne discloses:**

- *the appearance options based on the appearance of humans include male and female appearance options* (Col. 3, line 59-64; Figs. 2, 17-18;→ Human characters can illustrate a full range of human characteristics such as the customer's sex (e.g., male, female)).

**In regard to dependent Claim 4, Rosewarne discloses:**

- *ethnicity-based appearance options* (Col. 3, line 59-64; Figs. 2, 17-18;→ Illustrations (i.e., *characters*) can illustrate a full range of human characteristics such as the customer's ethnic features (*appearance feature, option*), indications of body size, hairstyle and length, glasses, freckles, and skin coloring (*gender and/or appearance options*).

**In regard to dependent Claim 5, Rosewarne discloses:**

- *the appearance options include one or more of:*
  - *whole-body-based appearance options (Figs. 17-21;→ whole bodies),*
  - *partial-body-based appearance options (Fig. 22;→ partial body).*

**In regard to dependent Claim 7, Rosewarne discloses:**

- *the book includes one of: an electronic book and a non-electronic book (Col. 9, line 20 through Col. 10, line 6;→ steps in producing a personalized custom, printed or hardcopy book (non-electronic)).*

**In regard to dependent Claim 13, Rosewarne discloses:**

- *providing an option to change at least one of: at least one selected appearance option, at least one selected name option, and at least one selected gender option (Fig. 5;→ one form of data input card for supplying information used to personalize the text and graphics. The card includes the name, address, age, and sex of the child, as well as date of birth and several physical characteristics).*

*In the case where the card is input by hand (e.g., pencil or pen), making changes is a matter of erasing one entry and replacing it with another.*

**In regard to Claim 23,** Claim 23 merely recites a *processor program stored on a processor-readable medium and comprising instructions to cause a processor to carry out the method of Claim 1.* Thus, Rosewarne discloses every limitation of Claim 23 as indicated in the above rejection for Claim 1.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 46-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Messner (U.S. Patent No. 6,370,514 filed 08/02/1999, issued 04/09/2002).

**In regard to independent Claim 46,** Messner discloses:

- A *method of redeeming gift certificates* (Abstract; → a method for marketing and redeeming vouchers (meaning gift certificates or coupons) for use in online purchases (from sites such as those offering books)), *the method comprising:*
  - *receiving a gift identifier associated with a gift certificate redeemable for purchase of the customized book, and data associated with the entity who requested the gift certificate* (Col. 6, lines 24-40; → gift certificates can be purchased by a gift sender and sent to a recipient. The gift certificate has associated with it at least an account number and optionally a pin

number/password for security. The voucher server keeps track of each gift certificate account separately (Col. 7, lines 5-6). The account is associated with the purchaser and contains purchaser information (Col. 8, lines 35-46)).

- *providing an option to send a message to the entity who requested the gift certificate associated with the received gift identifier* (Col. 8, lines 47-57; → purchaser provides contact information so that they can be notified when the recipient redeems the gift certificate or if there are problems delivering the gift certificate), and
- *based on receiving a selection of the option, sending the message to the entity who requested the gift certificate* (Col. 8, lines 47-57; Col. 9, lines 51-65; → a message is sent once a successful delivery has been made of the gift certificate from the purchaser to the recipient).

**In regard to dependent Claim 47, Messner discloses:**

- *identifying the entity includes: identifying the entity based on comparing the received gift identifier with at least one previously stored gift identifier, each of the at least one previously stored gift identifier being associated with data identifying the entity who requested the gift certificate* Figs. 1A-B; → steps to purchasing a gift certificate including the assignment and storage on the gift certificate site of identifiers that associate the gift certificate with the purchaser and options chosen for the gift certificate (Fig. 1B, Certificate information stored in voucher server).

Figs. 2A-B disclose steps for redeeming the gift certificate including steps to lookup the identifying information associated with the gift certificate to validate the gift certificate and to enable the transaction.

The steps of looking up the gift certificate information at the redemption step necessarily looks up information about the certificate purchase and the purchaser and reveals the previously stored gift identifier(s).

**In regard to dependent Claim 48, Messner discloses:**

- *identifying the entity further includes: identifying the entity based on a match between the received gift identifier and one of the at least one previously stored gift identifiers* (Figs. 1A-B; → steps to purchasing a gift certificate including the assignment and storage on the gift certificate site of identifiers that associate the gift certificate with the purchaser and options chosen for the gift certificate (Fig. 1B, Certificate information stored in voucher server).

Figs. 2A-B disclose steps for redeeming the gift certificate including steps to lookup the identifying information associated with the gift certificate to validate the gift certificate and to enable the transaction.

The steps of looking up the gift certificate information at the redemption step necessarily looks up information about the certificate purchase and the purchaser and reveals the previously stored gift identifier(s).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosewarne in view of Abram et al. (hereinafter Abram, U.S. Patent Application Publication No. 2002/0003631 filed 03/06/2001, published 01/10/2002).

**In regard to dependent Claim 6, Rosewarne fails to disclose:**

- *the illustrations include outlines for coloring.*

However, Abram discloses *the illustrations include outlines for coloring* (Pg. 1, Paragraph [0003]; → creating personalized and specialized coloring book images from their own digital images).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Abram as both inventions relate to the creation of books containing customized/personalized content. Adding the disclosure of Abram provides the benefit of creating characters from images that can be colored (e.g., with crayons)).

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11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosewarne in view of Hefty (U.S. Patent No. 5,190,316 filed 08/29/1991, issued 03/02/1993).

**In regard to dependent Claim 8, Rosewarne fails to disclose:**

- *based on the request, performing at least one of:*
  - *querying to provide a name for the author of the customized book, and*
  - *providing an author name feature, the author name feature:*
    - *(i) related to the name of the author of the customized book, and*
    - *(ii) associated with selectable name options.*

However, Hefty discloses

- *based on the request, performing at least one of:*
  - *querying to provide a name for the author of the customized book (see Fig. 6; → variable text data is entered into a computer, the variable information includes the author's name).*

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Hefty since both inventions are related to the production of a personalized custom book. Adding the disclosure of Hefty provides the specific benefit of allowing an author to personalize a book they've created by allowing them to enter their name).

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosewarne in view of Campbell (U.S. Patent Application Publication No. 2002/0077848 filed 12/19/2001, published 06/20/2002).

**In regard to dependent Claim 9, Rosewarne fails to disclose:**

- *based on the request, providing a plot feature, the plot feature:*
  - *(i) related to the plot of the customized book, and*
  - *(ii) associated with selectable plot options.*

However, Campbell discloses:

- *based on the request, providing a plot feature, the plot feature:*
  - *(i) related to the plot of the customized book, and*
  - *(ii) associated with selectable plot options* (Pg. 3, Paragraph [0035]; → the customer may modify the selected book in a number of different ways.

The customer can choose the various plot twists he or she finds desirable to create a customized story).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Campbell since both inventions relate to the creation of personalized custom books. Adding the disclosure of Campbell provides the benefit of further customization by allowing the author to select plot and plot twists in the story).

13. Claims 10-11, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosewarne in view of Cleveland (U.S. Patent No. 6,683,611 filed 01/14/2000, issued 01/27/2004).

**In regard to dependent Claim 10, Rosewarne fails to disclose:**

- *based on the request, providing a first book feature, the first book feature:*
  - *(i) related to the reading level of the book, and*
  - *(ii) associated with selectable reading-level options.*

However, Cleveland discloses *(i) related to the reading level of the book, and (ii) associated with selectable reading-level options* (Fig. 1B; Abstract→ a customized book with characters and text in a "role-play" reading format which has text corresponding to the dialogue of a plurality of characters in order to facilitate reading aloud in a group. The text for the dialogue of a plurality of characters is presented in different indicia throughout substantially all the presentation. Preferably the indicia is color so the dialogue for each character is in a different color. The text for each character is also selected and presented at a level corresponding to the reading level of the reader selecting or assigned to read each character. The text is preferably selected from among a plurality of texts pre-written at substantially different reading levels. The reading material can be presented on paper, or on media suitable for display on an electronic screen. The text for each character is in a size and font suitable for the reading level of the reader selecting or assigned to read the dialogue for the character. A legend on each page of the reading material correlates the identity of each reader with

the character or characters selected or assigned to be read by each reader, and with the indicia applied to the dialogue for each character).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Cleveland as both inventions are related to the creation of customized/personalized reading materials. Adding the disclosure of Cleveland provides the additional option of choosing a reading level for the reading material appropriate to the abilities of the persons reading the materials.

**In regard to dependent Claim 11, Rosewarne fails to disclose:**

- *based on a selected reading-level option, providing a second book feature, the second book feature: (i) related to the title of the book, and (ii) associated with selectable title options, at least two of the title options being associated with unique sets of words and accompanying illustrations.*

However, Cleveland discloses *(i) related to the title of the book, and (ii) associated with selectable title options, at least two of the title options being associated with unique sets of words and accompanying illustrations* (Col. 13, lines 1-7; Fig. 8; → that for the stories stored within a specific subject matter category, the information processor preferably displays a list of titles of the stories meeting the desired criteria entered by the readers in Step 28, or the information processor displays a summary or synopsis of the responsive story. Stories may also be categorized by the maturity of the subject matter).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Cleveland as both inventions are related to the creation of customized/personalized reading materials. Adding the disclosure of Cleveland provides the additional option of choosing from among titles selected according to a reading level.

**In regard to Claims 24 and 25,** Claim 24 and 25 merely recite a *processor program stored on a processor-readable medium and comprising instructions to cause a processor to carry out* the method of Claims 10 and 11, respectively. Thus, the combination of Rosewarne and Cleveland discloses every limitation of Claims 24 and 25 as indicated in the above rejections for Claims 10 and 11.

14. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosewarne in view of Gustafson et al. (hereinafter Gustafson, U.S. Patent Application Publication No. 2002/0025085 filed 03/27/2001, published 02/28/2002).

**In regard to dependent Claim 12,** Rosewarne fails to disclose:

- *providing a preview including at least one page of the customized book.*

However, Gustafson discloses *providing a preview including at least one page of the customized book* (Pg. 9, Paragraph [0102]; → a children's story book that can be customized/personalized; Pg. 3, Paragraphs [0042-0043]; → WebTemp, PrintTemp, preview versions of image renderings. The image renderings would be presented to the user to depict the current state of the book page containing an image).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Gustafson since both inventions are related to the production of customized and personalized books. Adding the disclosure of Gustafson provides the benefit of viewing a book design in-progress.

15. Claims 14-22, and 26-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosewarne in view of Messner.

**In regard to dependent Claim 14, Rosewarne fails to disclose:**

- *receiving a gift identifier associated with a gift certificate redeemable for purchase of the customized book, and data associated with the entity who requested the gift certificate,*
- *providing an option to send a message to the entity who requested the gift certificate associated with the received gift identifier, and*
- *based on receiving a selection of the option, sending the message to the entity who requested the gift certificate.*

However, Messner discloses *A method for customizing a book* as in claim 1 (Abstract; → a method for marketing and redeeming vouchers (meaning gift certificates or coupons) for use in online purchases (from sites such as those offering books)).

Messner further discloses *receiving a gift identifier associated with a gift certificate redeemable for purchase of the customized book, and data associated*

*with the entity who requested the gift certificate* (Col. 6, lines 24-40; → gift certificates can be purchased by a gift sender and sent to a recipient. The gift certificate has associated with it at least an account number and optionally a pin number/password for security. The voucher server keeps track of each gift certificate account separately (Col. 7, lines 5-6). The account is associated with the purchaser and contains purchaser information (Col. 8, lines 35-46)).

Messner further discloses *providing an option to send a message to the entity who requested the gift certificate associated with the received gift identifier* (Col. 8, lines 47-57; → purchaser provides contact information so that they can be notified when the recipient redeems the gift certificate or if there are problems delivering the gift certificate).

Messner further discloses *based on receiving a selection of the option, sending the message to the entity who requested the gift certificate* (Col. 8, lines 47-57; Col. 9, lines 51-65; → a message is sent once a successful delivery has been made of the gift certificate from the purchaser to the recipient).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift.

**In regard to dependent Claim 15, Rosewarne fails to disclose:**

- *providing the option without revealing at least one of the identity and contact information of the entity who requested the gift certificate.*

However, Messner discloses *providing the option without revealing at least one of the identity and contact information of the entity who requested the gift certificate* (Col. 8, lines 34-46; → that the purchaser can specify whether they want the purchase to be anonymous and/or a "surprise." If the purchaser elects to make the certificate to be anonymous, the recipient will not be notified who the certificate is from until the recipient "opens" the certificate. If the purchaser elects to make the certificate a surprise, the recipient will not know the amount nor the merchant(s)/mall(s) until he opens the certificate. If a certificate is delivered electronically (e.g., by e-mail), it will preferably be "opened" by selecting (i.e., double mouse clicking) an icon on the e-mail which, for example, looks like a wrapped package.)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism

whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift anonymously.

**In regard to dependent Claim 16, Rosewarne fails to disclose:**

- *the gift identifier is generated based on one or more of*
  - *a data compression scheme and*
  - *a data encryption scheme of data associated with the entity who requested the gift certificate.*

However, Messner discloses a *data encryption scheme of data associated with the entity who requested the gift certificate* (Col. 9, lines 35-50; → the purchaser is asked to enter personal information about the recipient, such as their birth date, business address, home address, hair color, home town, or the like. As used herein, "personal information" shall generally mean that minimum information necessary regarding both the purchaser and the recipient to enable the system to operate. When the certificate is delivered to the recipient they are asked to enter the same information provided by the purchaser. Preferably, a "natural language" text engine will be used to match the recipient's responses to those entered by the purchaser; otherwise, small differences in how the responses are entered might prevent the recipient from successfully redeeming the certificate.)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions

are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift and the gift certificate having security features associated with it.

**In regard to dependent Claim 17, Rosewarne fails to disclose:**

- *the message includes one or more of:*
  - *a video component and*
  - *an audio component.*

However, Messner suggests both a *video component and an audio component* (Col. 11, lines 20-29; → that upon receiving notification of the gift certificate, the recipient may be offered the option of sending a "thank you" card to the purchaser. Since the purchaser provided their address upon purchasing the gift certificate, the address will be available on the voucher server. Therefore, the recipient can simply select a card, which will then be automatically delivered to the purchaser. The recipient may also add a special thank you message to be included with the card to be delivered to the purchaser).

It would have been obvious to one of ordinary skill in the art at the time of invention that if a message can be personalized in the form of a special thank you, that the message could take any form including video, audio, or simply text. The

former two typically included as attachment files to be rendered either by the email application or by external applications as were typically used at the time of invention.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift and the recipient can respond with a thank you message that is personalized.

**In regard to dependent Claim 18, Rosewarne fails to disclose:**

- *providing, a first option for providing a pre-determined message to the entity who requested the gift certificate, and*
- *a second option for providing a customized message to the entity who requested the gift certificate.*

However, Messner discloses *providing, a first option for providing a pre-determined message to the entity who requested the gift certificate, and a second option for providing a customized message to the entity who requested the gift certificate* (Col. 11, lines 20-29; → that upon receiving notification of the gift certificate, the recipient may be offered the option of sending a "thank you" card to the purchaser. Since the purchaser provided their address upon purchasing the gift certificate, the address will be available on the voucher server. Therefore, the recipient can simply select a

card, which will then automatically be delivered to the purchaser (*first option, a predetermined message*). The recipient may also add a special thank you message to be included with the card to be delivered to the purchaser (*second option, a customized message*).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift and the recipient can respond with a thank you message that is either generic or is personalized.

**In regard to dependent Claim 19, Rosewarne fails to disclose:**

- *the pre-determined message expresses gratitude to the entity who requested the gift certificate associated with the received gift identifier.*

However, Messner discloses *the pre-determined message expresses gratitude to the entity who requested the gift certificate associated with the received gift identifier* (Col. 11, lines 20-26; → that upon receiving notification of the gift certificate, the recipient may be offered the option of sending a "thank you" card to the purchaser. Since the purchaser provided their address upon purchasing the gift certificate, the address will be available on the voucher server. Therefore, the recipient can simply

select a card, which will then automatically be delivered to the purchaser (a predetermined message).)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift and the recipient can respond with a thank you message that is either generic or is personalized.

**In regard to dependent Claim 20, Rosewarne fails to disclose:**

- *sending the message includes:*
  - *identifying the entity who requested the gift certificate based on comparing the received gift identifier with at least one previously stored gift identifier, each of the at least one previously stored gift identifier being associated with a gift certificate and data identifying the entity who requested the gift certificate.*

However, Messner discloses *identifying the entity who requested the gift certificate based on comparing the received gift identifier with at least one previously stored gift identifier, each of the at least one previously stored gift identifier being associated with a gift certificate and data identifying the entity who requested the gift certificate* (Figs. 1A-B; → steps to purchasing a gift certificate including the

assignment and storage on the gift certificate site of identifiers that associate the gift certificate with the purchaser and options chosen for the gift certificate (Fig. 1B, Certificate information stored in voucher server).

Figs. 2A-B disclose steps for redeeming the gift certificate including steps to lookup the identifying information associated with the gift certificate to validate the gift certificate and to enable the transaction.

The steps of looking up the gift certificate information at the redemption step necessarily looks up information about the certificate purchase and the purchaser and reveals the previously stored gift identifier(s).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift and the recipient redeem the gift certificate in a secure manner.

**In regard to dependent Claim 21, Rosewarne fails to disclose:**

- *identifying the entity further includes:*
  - *identifying the entity who requested the gift certificate based on a match between the received gift identifier and one of the at least one previously stored gift identifier.*

However, Messner discloses *identifying the entity who requested the gift certificate based on a match between the received gift identifier and one of the at least one previously stored gift identifier* (Figs. 1A-B; → steps to purchasing a gift certificate including the assignment and storage on the gift certificate site of identifiers that associate the gift certificate with the purchaser and options chosen for the gift certificate (Fig. 1B, Certificate information stored in voucher server).

Figs. 2A-B disclose steps for redeeming the gift certificate including steps to lookup the identifying information associated with the gift certificate to validate the gift certificate and to enable the transaction.

The steps of looking up the gift certificate information at the redemption step necessarily looks up information about the certificate purchase and the purchaser and reveals the previously stored gift identifier(s).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift and the recipient redeem the gift certificate in a secure manner.

**In regard to dependent Claim 22, Rosewarne fails to disclose:**

- *sending the message to the entity without revealing at least one of:*

- *the identity of the entity who requested the gift certificate, and,*
- *contact information of the entity who requested the gift certificate.*

However, Messner discloses *the identity of the entity who requested the gift certificate, and, contact information of the entity who requested the gift certificate* (Col. 8, lines 34-46;→ that the purchaser can specify whether they want the purchase to be anonymous and/or a "surprise." If the purchaser elects to make the certificate to be anonymous, the recipient will not be notified who the certificate is from until the recipient "opens" the certificate. If the purchaser elects to make the certificate a surprise, the recipient will not know the amount nor the merchant(s)/mall(s) until he opens the certificate. If a certificate is delivered electronically (e.g., by e-mail), it will preferably be "opened" by selecting (i.e., double mouse clicking) an icon on the e-mail which, for example, looks like a wrapped package.)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift anonymously.

**In regard to Claims 26, and 27,** Claim 26, and 27 merely recite a *processor program stored on a processor-readable medium and comprising instructions to cause*

*a processor to carry out the method of Claims 14, and 16, respectively. Thus, the combination of Rosewarne and Messner discloses every limitation of Claims 26, and 27 as indicated in the above rejections for Claims 14, and 16.*

**In regard to dependent Claim 28, Rosewarne fails to disclose:**

- *the data identifying the entity who requested the gift certificate includes contact information for the entity.*

However, Messner discloses *the data identifying the entity who requested the gift certificate includes contact information for the entity* (Col. 8, lines 47-57; → purchaser provides contact information (e.g., name and a mailing or email address) so that they can be notified when the recipient redeems the gift certificate or if there are problems delivering the gift certificate).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift and assuring the purchaser that their gift was delivered and/or redeemed.

**In regard to dependent Claim 29, Rosewarne fails to disclose:**

- *the contact information includes one or more of: an email address, a facsimile number, a postal mail address, and a telephone number.*

However, Messner discloses both *an email address and a postal mail address* (Col. 8, lines 47-57; → purchaser provides contact information (e.g., name and a mailing or email address) so that they can be notified when the recipient redeems the gift certificate or if there are problems delivering the gift certificate).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift and assuring the purchaser that their gift was delivered and/or redeemed.

**In regard to dependent Claim 30, Rosewarne fails to disclose:**

- *the data identifying the entity who requested the gift certificate includes a name of the entity who requested the gift certificate.*

However, Messner discloses *the data identifying the entity who requested the gift certificate includes a name of the entity who requested the gift certificate* (Col. 8, lines 47-57; → purchaser provides contact information (e.g., name and a mailing or email address) so that they can be notified when the recipient redeems the gift certificate or if there are problems delivering the gift certificate).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift and assuring the purchaser that their gift was delivered and/or redeemed.

**In regard to dependent Claim 31, Rosewarne fails to disclose:**

- *receiving the gift identifier via one or more of a wired telecommunications network, a wireless telecommunications network, an email communication, a facsimile communication, a postal mail communication, and a telephone communication.*

However, Messner discloses *a wired telecommunications network, a wireless telecommunications network, an email communication, and a telephone communication* (Col. 1, lines 34-37; → that the gift certificates are delivered electronically to the recipient after purchase either over the phone, at a brick and mortar store, at a virtual mall, at a merchant web site, or a web site ran by the operator of the gift certificate system.)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Rosewarne and Messner as both inventions are related to providing services to consumers for the creation and distribution of

gifts. Adding the disclosure of Messner provides the benefit of a mechanism whereby a purchaser can purchase, configure, and deliver a gift certificate to a recipient for obtaining a specified gift and assuring the purchaser that their gift was delivered and/or redeemed.

**In regard to Claims 32, 33, and 34-38** Claim 32, 33, 34-38 merely recites a gift certificate method for use with the method of Claims 17, 15, and 18-22 respectively. Thus, the combination of Rosewarne and Messner discloses every limitation of Claims 32, 33, and 34-38 as indicated in the above rejections for Claims 17, 15, and 18-22.

**In regard to Claims 39-42, 43, and 44-45**, Claims 39-42, 43, and 44-45 merely recite a processor program on a processor readable medium for carrying out the method of Claims 26-29, 33, and 36-37, respectively. Thus, the combination of Rosewarne and Messner discloses every limitation of Claims 39-42, 43, and 44-45, as indicated in the above rejections for Claims 26-29, 33, and 36-37.

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.
16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James H. Blackwell  
06/21/2007



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